

## REMARKS

This Amendment and Response is submitted in response to the Office Action mailed 29 SEPTEMBER 2003. Withdrawal of the rejection and reconsideration with an eye toward allowance is respectfully requested.

### Claim Status

Claims 1-2, and 5-19 are pending after entry of the present amendment. Claims 1-8 stand rejected, and claims 9-13 withdrawn. Claims 14-19 are added herein, and claims 3-4 cancelled. A complete listing of all claims that are, or were in the application, along with an appropriate status identifier, is provided above in the section entitled "Amendments to the Claims". Markings are provided on claims amended in the present amendment.

Support for the above new claims can be found throughout the originally filed specification, drawings, and claims, for example at pages 5-6.

### Claim Rejections – 35 U.S.C. §112, First Paragraph and Second Paragraph

Claims 3 and 4 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Claims 3 and 4 were rejected under 35 U.S.C. §112, second paragraph; as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Without admitting the propriety of the rejection, Applicants have cancelled claims 3 and 4 without prejudice or disclaimer towards presenting them in a related application.

### Claim Rejections – 35 U.S.C. §103

Claims 1-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cybul et. al. (U.S. Patent Number 6,246,997) in view of Ojha et. al. (U.S. Patent Number 6,598,026).

Cybul discloses an electronic commerce site, comprising: a point of sale (POS) system, having a POS loyalty database; a list builder tool having an on-line shopping history database; and a query interface between the POS system and the list builder tool (see abstract). The system enables a list builder tool to efficiently find and select the past shopping history of respective shoppers and import that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences (see col. 4, lines 24-33).

Ojha discloses an electronic commerce solution for facilitating online transactions which allows traditional negotiation between a buyer and a seller to occur (see abstract). In a specific embodiment, a

buyer may share his shopping list(s) with friend or co-workers to solicit feedback on the various products, sellers, ask prices, etc. (see col. 2, lines 64-65).

In contrast, Applicant's independent claim 1 recites "selecting a first line item from a first electronic receipt, thereby forming a list; and authorizing a group of people to review the list".

Applicant notes that to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings. Further, the reference (or references when combined) must teach or suggest all the claim limitations. (See M.P.E.P. §2142).

Applicant submits that there is not a suggestion or motivation to combine the reference teachings. The Examiner suggests that the motivation would be to help facilitate in creating a more reliable and trust buying experience in order to ensure customer satisfaction and increase the likelihood of future purchases (see office action, page 4). Ojha is directed to facilitating negotiations between a buyer and one or multiple sellers. Ojha states that by sharing a buyer's shopping list, a buyer may solicit advice or approval before initiating a transaction (see col. 3, lines 3-5). There is no motivation provided for combining this method of sharing a shopping list, of items which the prospective buyer would like advice or approval, with a method of the list building tool of Cybul that finds and selects the past shopping history of prospective shoppers. A person would not be motivated to combine Ojha's method of soliciting advice or approval prior to initiating a transaction with Cybul's method of identifying the shopping history of a shopper, as Ojha is concerned with a list generated prior to initiating a transaction, and Cybul is concerned with a list of historical shopping transactions. Accordingly, Applicant submits that proper motivation to combine the references is lacking, and the 35 U.S.C. §103(a) rejection is improper.

Further, Applicant submits that the references, taken alone or in combination, fail to teach all limitations of Applicant's independent claim 1, including "selecting a first line item from a first electronic receipt, thereby forming a list; and authorizing a group of people to review the list". Neither Cybul nor Ojha discloses selecting a line item from an electronic receipt. Cybul is limited to the disclosure of culling a single shopper's historical shopping records from a database. Ojha is limited to the disclosure of generating a shopping list of items. Accordingly, neither discloses the selection of a line item from an electronic receipt. Accordingly, Applicant submits that the 35 U.S.C. §103(a) rejection of claim 1 is improper, and should be withdrawn.

Claims 2-8 depend from and include all limitations of Claim 1, and Applicant submits that the 35 U.S.C. §103(a) rejection of claim 2-8 over Cybul in view of Ojha is improper at least for the reasons discussed above with regard to independent claim 1.

**New Claims**

Applicant has added new claims 14-19 which further distinguish over the cited art. For example, claims 14-15 recite participating in a transaction. Claims 16-17 recite a system, and claims 18-19 recite a computer program product. The added claims may present other features which are not present in the cited art.

**CONCLUSION**

Applicants submit the claims are in condition for allowance, and notification of such is respectfully requested. If after review, the Examiner feels there are further unresolved issues, the Examiner is invited to call the undersigned at (415) 781-1989.

Respectfully submitted,  
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